

### **REMARKS/ARGUMENTS**

In the Office Action mailed July 9, 2008, claims 1, 3, 6-13, 15, 18-26, 28, and 31-38 stand rejected under 35 U.S.C. § 103.

Reconsideration in light of the remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 103***

Claims 1, 3, 6-13, 15, 18-26, 28, and 31-38 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 6,637,029 issued to Maissel et al. (hereinafter Maissel) in view of U.S. Patent No. 5,589,892 issued to Knee et al. (hereinafter Knee).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

Further, as is well known in obviousness determinations, *impermissible hindsight must be avoided*. To prevent the use of hindsight based on the invention to defeat the patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness...In other words, the Examiner must show reasons that a skilled

artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453.

Applicant respectfully submits that there is no teaching, suggestion, or motivation as set forth by the Examiner to combine Maissel and Knee, and thus no *prima facie* case of obviousness has been adequately established, and further, even if Maissel and Knee were properly combinable, their combination would not teach or suggest the limitations of independent claims 1, 13, and 26.

Applicant respectfully submits that the Examiner has misinterpreted the teachings of Maissel and that Maissel does not teach or suggest the limitations of Applicant's independent claims as set forth by the Examiner.

In fact, the Examiner recognizes that Maissel fails to teach or suggest that upon a selection of a channel that is for a non-subscribed channel that the user is allowed to subscribe to that channel (Office Action, page 3).

In particular, Applicant respectfully submits that Maissel and Knee, alone or in combination, do not teach or suggest anything relevant to Applicant's claim limitations related to *recommending bundles of channels, subscription matrixes*, or any of the other particular limitations of Applicant's claims.

Even more particularly, Maissel and Knee do not teach or suggest Applicant's claim limitations related to:...upon the selection of a program guide entry that is for non-subscribed channel... *recommending at least one bundle of channels for subscriptions by the user based upon a subscription matrix for the user that is stored locally at the client terminal, the currently selected program guide entry for the non-subscribed channel displayed in the program guide, and available bundles of channels for subscriptions*...wherein...the *subscription matrix* includes *channel subscribed to by the client terminal and available channels not subscribed to by the client terminal*...accepting user input to *select a bundle of channels for subscription* by the

user...and...transmitting a subscription request for the selected bundle of channels to the video distribution system.

Contrary to the Examiner's assertions, Maissel and Knee are related to totally different inventions.

Looking particularly at Maissel, Maissel states that the: "...present invention provides for customization of an electronic program guide by an intelligent agent. Typically, the intelligent agent monitors viewing behavior of one viewer or a plurality of viewers and creates a preference profile based on the monitored viewing behavior. The intelligent agent then preferably employs the preference profile to customize the electronic program guide based on the preference profile." (Col. 3, lines 1-7). In particular, the invention of Maissel relates to an intelligent agent for customizing program schedule information based on a viewer preference profile to produce a program guide including customized program schedule information and displaying the program guide. (Col. 3, lines 17-21, emphasis added).

Applicant respectfully submits that Maissel is related to an intelligent agent for customizing program schedule information and that Maissel is not related to, and in no way teaches or suggests, recommending bundles of channels based upon a subscription matrix that is stored locally at the client terminal.

To begin with, Applicant respectfully submits that, contrary to the Examiner's assertion on page 3 of the Office Action, that column 18, lines 29-42 of Maissel in no way teaches or suggests recommending at least one bundle of channels to a user based upon a subscription matrix for the user that is stored locally at the client terminal.

Applicant has reviewed column 18, lines 29-42 of Maissel and can find no teaching or suggestion of recommending at least one bundle of channels to the user based upon a subscription matrix for the user that is stored locally at the client terminal.

Instead, this section of Maissel relates to Figure 8A of Maissel which teaches a "head end 340 [that] comprises a head end intelligent agent 360 and a head end profile storage unit 370, which may be similar respectively to the intelligent agent 130 of FIG.1 and the profile storage

unit 140 of FIG.1 respectively...” (Col. 18, lines 40-44). Even more particularly, the head end profile storage unit 370 as relied upon by the Examiner is further defined as being “typically operative to store viewer preference profiles for a wide variety of viewers located at a multiplicity of cites.” (Col. 18, lines 58-60).

As repeatedly defined in the detailed description of the Maissel patent, the intelligent agent is used to monitor the viewing behavior of a viewer or a plurality of viewers and to create a preference profile based on the monitored viewing behavior and the intelligent agent may then employ the preference profile to customize the electronic program guide based on the preference profile.

Maissel is in no way is related to *recommending at least one bundle of channels to a user based upon a subscription matrix that is stored locally at the client terminal*.

The Examiner further relies on column 14, lines 20-24 and lines 34-37 of Maissel for allegedly teaching or suggesting wherein the subscription matrix includes channels subscribed to by the client terminal and available channels not subscribed to by the client terminal. (Office action, page 3). However, column 14, lines 20-24 and lines 34-37 of Maissel actually teach: “...that other factors in addition to a viewer preference profile may also be applied by the intelligent agent 130. Examples of such other factors and their typical use by the intelligent agent 130 include the following:...subscription information, typically including information on televisions services which have been subscribed to by a viewer, may be used to eliminate programs not subscribed for from the program guide...”

Thus, this citation of column 14 of Maissel relates merely to the fact that other factors may be utilized by the intelligent agent 130 for the presentation of an electronic program guide such as subscription information along with a variety of other information such as: parental control information, rating information, language choice information, as well as a plurality of others.

The Examiner further states that accepting user input to select a bundle of channels for subscription by the user is taught by Maissel at column 16, lines 33-39 and column 20, lines 50-60.

This is quite simply not the case.

Column 16 relates to television viewing information that may comprise an indication that a viewer has responded to a customized alert positively, by tuning to the program named in the alert, or negatively, by not tuning to the program named in the alert. The citation in column 20 merely relates to selecting programs using methods well known in the art such as by moving a cursor, selecting programs with a mouse, or by other input devices. Neither of these citations in any way relate to accepting user input to select the bundle of channels for subscription by a user.

Maissel quite clearly in no way teaches or suggests Applicant's claim limitations related to: *recommending at least one bundle of channels for subscription* by a user based upon a *subscription matrix* for the user that is stored locally at the client terminal, the currently selected program guide entry for the non-subscribed channel displayed on the program guide, and available bundle of channels for subscription, wherein the subscription matrix includes channels subscribed to by the client terminal and available channels not subscribed to by the client terminal.

As described in detail above, Maissel does not teach or suggest in any way, these claim limitations.

As to Knee, Knee is directed to an electronic program schedule system with access to both stored television program schedule information and data feeds containing status information for live programs such as sporting events. (Abstract). Knee is merely cited because it allegedly teaches that upon a selection of a non-subscribed channel, that it allows for the user to subscribe to the non-subscribed channel.

However, like Maissel, this in no way teaches or suggests recommending at least one bundle of channels to a user based upon a subscription matrix that is stored locally at a client terminal wherein the subscription matrix includes channels subscribed to by the client terminal and available channels not subscribed to by the client terminal. In fact, like Maissel, Knee is not in any way related to recommending bundles of channels or the use of subscription matrixes.

Further, there is no rational reason as set forth by the Examiner to combine Maissel and Knee, except for *impermissible hindsight* to reconstruct Applicant's claims, which is improper.

Applicant respectfully submits that Maissel and Knee, either alone or in combination, do not expressly or implicitly teach or suggest the limitations of Applicant's independent claims 1, 13, and 26. Further, as previously discussed, Maissel and Knee are not properly combinable.

Therefore, Applicant respectfully submit that independent claims 1, 13, and 26, and the claims that depend therefrom, are distinguishable over the prior art references and Applicant respectfully requests that these claims be allowed and passed to issuance.

***Conclusion***

In view of the remarks made above, it is respectfully submitted that pending claims 1, 3, 6-13, 15, 18-26, 28, and 31-38 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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